

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed May 20, 2004, is respectfully requested in view of the following comments.

Initially, applicants note that the Examiner has rejected claims 114-130 under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter citing, *inter alia*, Pannu v. Storz Instruments Inc., 59 USPQ 2d 1597 (Fed. Cir. 2001); and In re Clement, 45 USPQ 2d 1161 (Fed. Cir. 1997).

Although the Office relies on the Pannu and Clement decisions, applicants respectfully submit that since the date of such decisions by the Federal Circuit, the United States Patent and Trademark Office has changed its policy on reissue recapture which is binding precedent upon the Examiner, in the matter of in Ex Parte Eggert, an *en banc* decision of the Board of Patent Appeals and Interferences (2003), a copy of which has previously been provided for the Examiner's convenience.

This precedential opinion controls all proceedings within the United States Patent and Trademark Office with regard to the issue of recapture and, thus, supercedes the decisions relied upon in the Office Action of Pannu and Clement.

However, even if one were to follow the Office Action reasoning rely on Pannu and Clement, it is uncontested that the second step of the Clement test, i.e., to determine whether the broadened aspects (i.e., the method claims) of the reissue claim relate to surrendered subject matter, clearly must be answered in the negative.

As previously pointed out and extensively argued in preceding responses (herein incorporated by reference), there was no cancellation of subject matter involving manipulative steps as in presently recited method claims 114-130. The subject matter to which the Examiner comments in the rejection are directed or referred to apparatus limitations which find no identifiable correspondence in the rejected method claims 114-130. See, for example, the discussion bridging pages 23-28 of applicants' response filed February 23, 2004.

For the foregoing reasons, withdrawal of the rejection of claims 114-130 under 35 U.S.C. §251 as allegedly being an improper recapture of broadened subject matter is respectfully requested.

Applicants again note the rejection of the claims under 37 C.F.R. §1.175(b)(1) requiring a Supplemental Reissue Oath/Declaration under 37 C.F.R. 1.175(b)(1) as "must be received" before the reissue application can be allowed. Reconsideration of this rejection is respectfully requested.

Current United States Patent and Trademark Office practice does not require reissue applicants to continuously file Supplemental Reissue Declarations until the claims are in condition for allowance. See, MPEP §1444 (p. 1400-54, Rev. 2, May 2004). Applicant has already provided numerous Supplemental Reissue Declarations in response to the Examiner's requests. However, applicants believe that the Examiner's continuing request that a Supplemental Reissue Declaration must be provided prior to allowance of the claims is erroneous. Current practice only requires that a Supplemental Reissue Declaration be submitted prior to patenting of the reissue application; See, MPEP §1444 "Supplemental Reissue Oath/Declaration under 37 C.F.R. §1.175(b)(1).

However, applicants hereby attach a Supplemental Reissue Declaration, newly executed by the reissue applicants, adopting the suggested language as set forth by the Examiner in paragraph 8 of the preceding Office Action.

Reconsideration and withdrawal of all rejections under 35 U.S.C. 103(a) is respectfully requested in view of the following comments.

All of the prior art rejections rely, at least in part, on Sokal et al (U.S. Patent 5,953,504, filed October 10, 1995).

However, as the Office Action concedes, applicants have provided evidence of conception of the invention prior to the Sokal reference and, in fact, have satisfied demonstrating diligence from March 19, 1996, until the filing date of U.S. Patent Application No. 08/715,232. Applicants hereby submit further evidence of diligence in the time period just prior to the filing date of October 10, 1995, of Sokal to March 19, 1996.

This evidence is in the form of a verified Declaration of James A. Satchell, Jr., including supporting exhibits and additional declarations. In the Declaration of James A. Satchell, Jr., the entire time period from just prior to the filing of the Sokal et al reference until March 19, 1996, is demonstrated in numbered paragraphs, with supporting exhibits. Although the statements in the James A. Satchell, Jr. declaration supporting activity toward reducing the invention to practice throughout the entire period of time in question are self-explanatory, the undersigned does highlight the fact that just prior to the filing date of the Sokal et al document, James A. Satchell, Jr. had made further drawing embodiments of the invention, when he was subject to the ravages of Hurricane Opal

during which he endured an extended period of time (from prior to the filing date of Sokal et al to October 18, 1995) without electricity in his state residence in and surrounding Tuskegee, Alabama.

However, as further detailed in the declaration, upon the restoration of electricity, he promptly began a lengthy period of preparation of drafting a further description of the invention which ultimately resulted in the submission date-stamped by the United States Patent and Trademark Office on December 26, 1995. Such activity is verified by a supporting declaration.

Subsequent to that preparation, Declarant Satchell continues to support the entire time period in question, with statements and exhibits detailing his continued diligence on reducing the invention to practice, including certain time periods in which full-time employed in order to earn a living and his other duties as a minister in his church.

The attached evidence satisfies applicants burden of showing diligence in the entire time period questioned by the preceding Office Action and, in view of the antedating of the Sokal patent as a reference, each of the rejections which rely, in part, on Sokal must fail. Accordingly, withdrawal of all rejections which rely at least on part Sokal (U.S. Patent 5,953,504) is respectfully requested.

Because the rejections must fail due to the antedating of one of the cited references, further discussion is not necessary as to the teachings of the remaining references as they are insufficient without Sokal et al to establish a *prima facie* case of obviousness for the claims rejected thereon.

Moreover, since claims 114-122, 124-127, 129 and 130 are rejected solely under 35 U.S.C. §102(e) as being anticipated by Sokal et al (U.S. Patent 5,953,504), this rejection must also fail.

Reconsideration of the previous rejection of claims 127, 129 and 130 under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Huegel (U.S. Patent 5,239,480) is respectfully traversed.

As noted in the preceding Amendment, the limitations of previous claim 128 have been combined with claim 127 and as claim 128 was not objected over Huegel, such amendment avoids the rejection which should be withdrawn.

Reconsideration and withdrawal of the previous rejection of claims 114-118, 122, 124-127 under 35 U.S.C. §102(e) as being anticipated by Mettke (U.S. Patent 5,602,905) is respectfully requested.

Applicants do not agree that Mettke “is a vending machine” and, in this regard, applicants note that the Examiner acknowledges that Mettke “does not use the term ‘vending machine.’” However, in order to further distinguish the claimed invention from Mettke, claim 114 has been further amended to state that the vending machine will “vend at least one physical item selected by a customer for purchase.” Such a machine is not the machine taught by Mettke because, as the Examiner notes, Mettke, at best, only “vends services,” but not “a physical item selected by a customer for purchase” as recited in the instant claims. In view of the foregoing, withdrawal of the rejection is respectfully requested. Also, withdrawal of the rejection of claim 120 over the combination of Mettke discussed above in view of Ishizaki et al (U.S. Patent 5,699,328) under 35 U.S.C. §103(a) is also respectfully requested in view of the foregoing amendment.

Reconsideration and withdrawal of the rejection of claims 114-118, 122, 124-125, 127 and 130 under 35 U.S.C. §102(e) as being anticipated by Kolls (U.S. Patent 5,637,845) is respectfully requested.

As noted above, independent claim 114 has been amended to recite providing a vending machine to vend at least one physical item selected by a customer for purchase. Kolls does not teach such a method. As acknowledged in the Office Action, Kolls “provides for purchasing time to access the internet.” However, there is nothing in Kolls to show that other than purchasing time to access the internet is there provided any vending of physical items selected by a customer for purchase. For the foregoing reasons, withdrawal of the purported anticipation rejection over Kolls is respectfully requested.

Having fully responded to the preceding Office Action, favorable reconsideration and withdrawal of all rejections set forth therein and immediate allowance of the application is respectfully requested.

Respectfully submitted,



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ATTACHMENT I

114. (Currently Amended) A method of providing a customer with access to the Internet via a vending machine, said method comprising:

- 1.) providing a vending machine to [dispense] vend at least one physical item selected by a customer for purchase;
- 2.) said purchase of said at least one item permits the customer to be operatively connectable via the Internet to websites;
- 3.) allowing access to the websites by said customer, said access comprising at least one of inserting money or credit card information into the vending machine and customer input of data to the computer.

127. (Currently Amended) A method of attracting greater patronage to a vending machine, said method comprising:

providing a vending machine with a connection to the internet/worldwide web; and permitting a customer access to websites on said internet/worldwide web through interaction with said vending machine, wherein at least part of said access is located on a door of the vending machine.